



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,995	01/28/1999	JOSEPH C. KAWAN	CITI0122-US	5611
27510 7590 10/31/2007 KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			EXAMINER FELTEN, DANIEL S	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/238,995	<b>Applicant(s)</b> KAWAN, JOSEPH C.	
	<b>Examiner</b> Daniel S. Felten	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 10-17, 22, 27, 33, 39, 42-50, 55-58, 63-66, 69-74 and 79-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10-17, 22, 27, 33, 39, 42-50, 55-58, 63-66, 69-74 and 79-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Receipt of the applicant's amendment is acknowledged. The applicant has made a minor amendment to the claims to read a "financial transaction," smart card and/or smart card applications. Claims 1-5, 8, 10-17, 22, 27, 33, 39, 42-50, 55-58, 63-66, 69-74 and 79-81 are pending in the application and presented to be examined upon their merits.

### ***Response to Arguments***

2. Applicant's arguments filed August 22, 2007 have been fully considered but they are not persuasive. As stated above, the applicant has amended the claims to read a "financial transaction" smart card. In regards to applicant's piecemeal analysis to the references, the examiner respectfully submits that one can not show non-obviousness by attacking references individually where, as here, the rejections are based upon a combination of references. Specifically, the applicant asserts that Gutman teaches nothing more than a magnetic stripe card/reader writer of and electronic wallet that reads and writes magnetic data on a magnetic stripe and that a magnetic stripe is incapable of having a bi-directional interface with a handheld computing device. Moreover, the applicant simplistically asserts that the logical conclusion that examiner has made is analogous of one reading from and writing to a piece of paper. The examiner disagrees with this for the following reason(s): The applicant provides an analogy by which only one source writes into and reads from the financial card via the electronic wallet. However, the financial card similarly to applicant's smart card, provides bi-directional communication via a means for indicating reading and/or writing to the user (see column 5, line 44 to column 6, lines 7-9) and for receiving information from and providing to the financial card

Art Unit: 3693

where the electronic wallet is a wireless conduit for financial transactions for the financial card (see column 8, lines 43+; and see figures 5A-D, column 12, lines 33 to column 15, line 41). The deficiencies of Gutman have been previously mentioned in the 35 USC 103 rejection mailed May 18, 2007. In the rejection it indicates how Gutman fails to teach a smart card per se, and how Dagger discloses a electronic wallet which can use both a smart card and a magnetic card to make various financial transactions (see figure 2A, column 10, line 45 to column 11, line 52; and column 12 line 1-41) where the financial advantages of the smart card are also disclosed (see column 12, lines 1+). It is reiterated that it would have been obvious for one of ordinary skill in the art at the time of Gutman to recognized the advantages of the micromodules used in smart cards to satisfy customers needs for convenience, security; payee needs for faster, safer more cost-effective operations as enunciated in Dagger (see column 9, line 63+); and to provide the latest electronic wallet technology to allow existing infrastructures to accept new digital transactions, provide digital card storage, fraud protection, etc., as enunciated in Dagger (see Dagger, column 8, lines 3-43).

It is also reiterated that Coutts was used to show that the art teaches bidirectional communication between a PCMCIA card and a ATM via an interface device (see Coutts, Abstract, column 2, lines 54 to column 3, line 23) and that it would have been obvious for Gutman to have sought to modify and/or substitute the PCMCIA disclosed in Coutts because Gutman would have sought the latest financial card technology to make secure transactions.

It should also be addressed that the applicant's argument implies that the examiner's conclusion of obviousness is based upon improper hindsight reasoning: however, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based

Art Unit: 3693

upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). For the reasons stated above and also presented in the office action dated May 18, 2007, the rejections are maintained below and are provided again for the applicant's convenience.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5, 8, 10-17, 22, 27, 33, 39, 42-45, 47-50, 55-58, 63-66, 69-74, 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Gutman et al (US 5221, 838) in view of Dagger (US 5,748,737) and Coutts (US 5,563,393).

Gutman shows a method of contact less interfacing for a finance card which allows a user to establish a physical contact communication interface between a financial card (22) and a hand-held computing device (electronic wallet) for accessing a financial card application on the of the financial card (see col. 5, lines 44-65), *As in claims 1 and 63*

Art Unit: 3693

--identify information and transaction information on the hand-held computing device (see col. 5, lines 57-59; and col. 7, lines 66 to col. 8, lines 2), *as in claims 1 and 63*

--initiate a contact less bi-directional communication interface via the hand-held computing device between the smart card application and a self-service transaction terminal of an on-line system of a financial institution (see fig. 1, col. 3, lines 46-68; and col. 4, lines 36-54), *as in claim 1 and 63*

--verify the financial card by the on-line system based at least in part on the identifying information received by the on-line system via the contact less communication interface between the hand-held computing device and the self-service transaction terminal (see col. 7, lines 66 to col. 8, line 2), *as in claims 1, 63 and 81 and*

--communicate the transaction information entered by the user on the hand-held computing device to the self-service transaction terminal of the on-line system via the contact less communication interface (see figs. 5B-5E, col. 12, line 64+; and col. 14, lines 17+), *as in claims 1, 63 and 81*

Gutman discloses that the financial card is a magnetic card that is used to exchange information, but fails to disclose that the financial card is a smart card. Dagger teaches that electronic purse systems have generally adopted the smart card for contact retail payments and non-contact cards for transportation payments such as tolls (see Dagger, col. 1, lines 57-67). Dagger also discloses Gutman failing to use the smart card (see col. 6, lines 36+). It would have been obvious for one of ordinary skill in the art to modify/substitute the smart card of Dagger for the magnetic card of Gutman to provide the latest electronic wallet technology to allow existing infrastructures to accept new digital card transactions, provide digital card storage, reduce

Art Unit: 3693

fraud, etc., as enunciated in Dagger (see Dagger, col. 8, lines 3-43). Thus such modification would have been an obvious expedient to one of ordinary skill in the art.

Coutts discloses an interface device 12, that uses bi-directional communication between a PCMCIA card and a ATM via a interface device (see Coutts, Abstract, column 2, line 54 to column 3, line 23). It would have been obvious for an artisan of ordinary skill at the time to the invention to recognize that Gutman would have sought to modify it's invention with the PCMCIA card as provided in Coutts because an artisan would have desired the latest card technology to make secure financial transactions. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

*As in claims 2 and 64*, wherein the contact-less communication interface further comprises an infrared communication interface (see Gutman, col. 4, lines 36-54).

*As in claims 3 and 65*, wherein the contact less communication interface further comprises a wireless communication interface(see Gutman, col. 4, lines 36-54).

*As in claim 4 and 66*, further comprises a radio frequency communications interface(see Gutman, col. 4, lines 36-54).

*As in claim 5*, wherein the wireless communication interface(see Gutman, col. 4, lines 36-54)

*Re in claim 6*, wherein the radio frequency communication interface further comprises a proximity communication interface (see Gutman, col. 4, lines 35-55) .

*As in claim 8*, wherein the financial institution further comprises a bank (see Gutman, col. 7, lines 50-53).

*As in claim 9*, wherein allowing the user to initiate the contact less communication interface between the financial card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communications interface through a contact less communication transceiver of the terminal (see Gutman, col. 9, lines 10-26).

*As in claim 11*, wherein allowing the user to initiate the contact less communication interface between the smart card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communication interface through an ignored transceiver of the terminal (see Gutman, col. 9, lines 10-26).

*As in claims 12 and 69*, wherein the self-service transaction terminal further comprises an automated teller machine (see Dagger, col. 20, lines 11-19),

*As in claim 13 and 70*, wherein the self-service transaction terminal further comprises a personal computer (see Gutman, col. 9, lines 37-44).

*As in claims 14 and 71*, wherein the self-service transaction terminal further comprises a telephone (304) (see Gutman, fig. 4, col. 10, lines 66 to col. 11, line 50).

*As in claims 15*, wherein the self-service transaction terminal further comprises a wireless telephone (see "pager," col. 11, lines 9+).

*As in claim 16*, wherein allowing the user to initiate the contact less communication interface between the financial card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communication interface through a wireless transceiver of the terminal (see "pager," col. 11, lines 9+).

*As in claim 17*, wherein the Wireless transceiver further comprises a radio frequency transceiver of the terminal (see col. 4, lines 36-54).



*As in claim 22*, wherein allowing the user to initiate the contact less communication interface between the financial card application and the self-service transaction terminal further comprises allowing the user to initiate the contact less communication interface through a proximity transceiver of the terminal (see Gutman, col. 4, lines 35-55),

*As in claim 27*, wherein allowing the user to initiate the contact less communication further comprises allowing the user to initiate the contact less communication between the contact less communication transceiver of the self-service transaction terminal and a contact less communication transceiver of the hand-held computing device comprising a personal data assistant (electronic wallet) (see col. 9, lines 10-26).

*As in claim 33*, wherein the personal data assistant further comprises an electronic purse or wallet (see Abstract; also col. 3, lines 46+).

*As in claim 39*, wherein verifying the smart card further comprises verifying the smart card by the on-line system based at least in part on the identifying information received by the on-line system via the contact less communication interface between the hand-held computing device comprising a personal data assistant and the self-service transaction terminal(see col. 7, lines 66 to col. 8, line 2).

*As in claim 42*, wherein verifying the smart card further comprises verifying the authenticity of the financial card (see col. 7, lines 66 to col. 8, line 2).

*As in claim 43*, wherein verifying the financial card further comprises checking security information for the user.

Art Unit: 3693

*As in claim 44*, wherein checking security information further comprises receiving security information for the user (see col. 7, lines 66 to col. 8, line 2).

*As in claim 45*, wherein receiving security information further comprises receiving a PIN number (e.g. password) for the user (see col. 7, line 66 to col. 8, line 2).

*As in claim 47*, wherein receiving security information further comprises receiving the security information on an input/output device (see col. 7, lines 66 to col. 8, line 2)

*As in claim 48 and 73*, wherein receiving the security information further comprises receiving the security information through an input output device of the hand-held computing device comprising a personal data assistant (see col. 9, lines 10-26).

*As in claim 49 and 74*, wherein the personal data assistant comprises an electronic purse or wallet (see col. 9, lines 10-26).

*As in claim 50*, wherein receiving the security information further comprises receiving the information through the input/output device of a terminal (see col. 7, line 66 to col. 8, line 2)

*As in claims 55*, wherein allowing the user to enter the transaction information further comprises receiving the information through an input/output device (see col. 7, line 66 to col. 8, line 2)

*As in claim 56*, wherein receiving the information further comprises receiving the information through the input/output device of the hand-held computing device comprising a personal data assistant (see col. 7, line 66 to col. 8, line 2)

*As in claim 57*, wherein the personal data assistant comprises an electronic purse or wallet (see col. 9, lines 10-26).

Art Unit: 3693

*As in claim 58*, wherein receiving the information further comprises receiving the information through the input output device of a terminal(see col. 7, line 66 to col. 8, line 2)

*As in claim 72*, The system of claim 63, wherein the on-line system comprises a bank host on-line system (see Gutman, col. 7, lines 50-53).

*As in claim 75*, wherein the accessing of the smart card application comprises executing the smart card application (see Dagger, col. 12, lines 1-8).

*As in claim 80*, wherein the accessing of the smart card application comprises loading the smart card application (see Gutman, col. 7, lines 50-53)

Re claim 46: computer systems receiving biometric information from a user (e.g., fingerprint, retina scan etc.,) is notoriously old and well known for retrieving information that is uniquely and readily available from the user and is matched against the system's database to provide access similar to that of other well known techniques (e.g. PIN, password, etc.,). Thus Official Notice is taken of receiving biometric information because one of ordinary skill in the art would have recognized biometric data as an obvious alternative to the PIN and/or password disclosed in Gutman and Dagger to access their systems and to perform various transactions. Thus an artisan would have recognized the fact that to provide a fingerprint or a retina scan would substitute for a PIN number or password in the event that the PIN number and/or password was forgotten or lost. Thus the such a modification would be well within the ordinary skill of the art as well as being an obvious extension to the teachings of Gutman and Hsu to continue to allow users to access their systems without a PIN and/or password per se.

### ***Conclusion***

Art Unit: 3693

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712 . The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Daniel S Felten  
Examiner  
Art Unit 3693

DSF  
10/22/2007